



*AF JW*

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q64575

Tsuyoshi INOUE, et al.

Appln. No.: 09/874,314

Group Art Unit: 1771

Confirmation No.: 6107

Examiner: Daniel R. Zirker

Filed: June 6, 2001

For: SHEET FOR PROTECTING PAINT FILM

**SUBMISSION OF APPEAL BRIEF**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. A check for the statutory fee of \$340.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

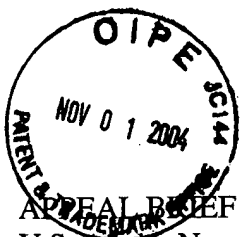
WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: November 1, 2004

*Mark Boland / MRD Reg No. 32,197*  
Fang Liu  
Registration No. 51,283



APPEAL BRIEF UNDER 37 C.F.R. § 41.37

U.S. Appl. No.: 09/874,314

Attorney Docket No.: Q64575

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q64575

Tsuyoshi INOUE, et al.

Appln. No.: 09/874,314

Group Art Unit: 1771

Confirmation No.: 6107

Examiner: Daniel R. Zirker

Filed: June 6, 2001

For: SHEET FOR PROTECTING PAINT FILM

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

**I. REAL PARTY IN INTEREST**

The real parties in interest are the Assignees, Nitto Denko Corporation and Kansai Paint Co., Ltd. An assignment was filed in U.S. Application No. 09/874,314 on June 6, 2001, and recorded at reel 011885, frame 0589.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

U.S. Appln. No.: 09/874,314

Attorney Docket No.: Q64575

## **II. RELATED APPEALS AND INTERFERENCES**

Appellants, Appellants' counsel, and the assignees of the application are not aware of any other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

## **III. STATUS OF CLAIMS**

Claims 1 and 2 are pending in the application.

Claims 1 and 2 are rejected.

Claims 1 and 2 are being appealed.

Claims 1 and 2 are set forth in their entirety in the Claims Appendix submitted herewith.

## **IV. STATUS OF AMENDMENTS**

On June 25, 2004, a Response Under 37 C.F.R. § 1.116 was filed in response to the final Office Action mailed April 1, 2004.

The Advisory Action mailed July 12, 2004, indicates that the remarks submitted with the June 25th Response were considered but did not place the application in condition for allowance. The Examiner provided comments with the Advisory Action stating that because Appellants' remarks were not sufficiently persuasive to overcome the rejection, the application was not in condition for allowance.

## **V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

Claim 1 is drawn to a sheet for protecting a paint film. Page 3, lines 12-13, of the specification. The sheet comprises a substrate having a rubber-based pressure-sensitive adhesive layer formed on one side thereof. Page 4, lines 9-10. The rubber-based pressure-sensitive adhesive layer further comprises a rubbery polymer and incorporated therein at least one copolymer selected from the group consisting of styrene/hydrogenated terpene copolymer resins and hydrogenated aliphatic/aromatic copolymer petroleum resins. Page 4, lines 11-13 and page 5, lines 14-27. The sheet of the invention may be used for the surface protection of automotive bodies and parts, coated steel sheets, etc. Page 1, lines 6-8. Advantageously, the sheet of the invention is satisfactorily adhered to a paint film and can be easily removed after long-term adhesion, even when applied to a paint film on which fouling substances (dust particles, rain, stone debris, etc.) are apt to remain after protective sheet removal. Page 1, lines 1-6.

Claim 2 depends from claim 1. Claim 2 further requires that the amount of the copolymer incorporated is from 0.2 to 5 parts by weight per 100 parts by weight of the rubbery polymer. Page 6, lines 8-11.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,643,676 ("Dobashi et al") in view of EP 0273585 ("EP '585").

## **VII. ARGUMENT**

### **A. §103 Obviousness Rejection of Claims 1-2**

Claims 1-2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dobashi et al in view of the EP '585 reference.

Dobashi et al is directed to a coating protective film coating used temporarily to protect automobile bodies during transportation and storage. (Col. 1, lines 5-8). The Dobashi et al film includes a substrate and a pressure sensitive adhesive layer on the substrate; the pressure sensitive adhesive layer further includes a polymer having as a main component polyisobutylene, butyl rubber and polybutene, a release agent, a tackifier, and at least one additive for automotive paint. (Col. 2, lines 26-41). Various tackifiers are disclosed (Col. 4, line 63 - Col. 5, line 7), none of which include the copolymer tackifiers of the claimed invention.

Importantly, the Examiner concedes Dobashi et al's failure to disclose the hydrogenated aliphatic/aromatic copolymer petroleum resins of the claimed invention. (Final Office Action, 4/1/04 at 2). Notwithstanding, the Examiner asserts that the claimed invention would have been obvious based on the incorporation of the tackifier disclosed in the EP '585 reference in the adhesive compositions of Dobashi et al. According to the Examiner, one skilled in the art would have been motivated to combine the references based on an expectation of successfully obtaining the advantages described in the EP '585 reference.

B. The Error in the Rejection

The rejection based on the combination of Dobashi et al and EP '585 is improper and fails to establish a *prima facie* case of obviousness. In particular, the Examiner has set forth neither sufficient motivation to combine the selected teachings of the Dobashi et al and EP '585 references, nor provided any basis for an expectation of success even if the references could properly be combined.

Alternatively, even assuming the references could be properly combined, the evidence of record rebuts any inference of *prima facie* obviousness.

C. Present Claims 1-2 are Patentable Under 35 U.S.C. § 103

1. The Prior Art Fails to Raise a Case of *Prima Facie* Obviousness

To establish a *prima facie* case of obviousness, the Examiner must show three criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. *See* MPEP §2143.01 (2004); *In re Thrift*, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2007 (Fed. Cir. 2002). Second, there must be a reasonable expectation of success. *See* MPEP §2143.02 (2004); *In re Inland Steel Co.*, 265 F.3d 1354, 1362-64, 60 USPQ2d 1396, 1401-03 (Fed. Cir. 2001). Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art and not based on Applicants' disclosure. *See* MPEP §

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

U.S. Appln. No.: 09/874,314

Attorney Docket No.: Q64575

706.02(j) (2004); MPEP §2143.03 (2004); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) ( “There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.”); *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Under this framework, the Examiner has not made a sufficient showing of *prima facie* obviousness.

The Dobashi et al reference discloses a film for protecting automobiles during transfer and storage thereof, comprising a substrate made of a colored polyolefin film and a pressure sensitive adhesive layer made of a pressure sensitive adhesive containing as the main component at least one of polyisobutylene, butyl rubber and polybutene. *See* Dobashi et al Abstract. The Dobashi et al inventors sought to solve certain problems of prior art film coatings, including: (1) difficulty of film removal; (2) insufficient durability; and (3) deterioration of the automobile’s finish. (Col. 1, line 11 - Col. 2, line 16). Dobashi et al does not disclose, teach or suggest the styrene/hydrogenated terpene copolymer resins or hydrogenated aliphatic/aromatic copolymer petroleum resins as presently claimed, as the Examiner has conceded. *See* Final Office Action, 4/1/04 at p. 2.

To supplant this deficiency, the Examiner has relied on the EP ‘585 reference, which discloses a coated substrate such as an adhesive tape obtained by coating with a solution of a mixture of a rubber and a tackifier dissolved in a solvent. *See* EP ‘585 Abstract. The EP ‘585 reference further discloses that in order to achieve the desired adhesive properties of an adhesive

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

U.S. Appln. No.: 09/874,314

Attorney Docket No.: Q64575

tape, the rubbers are generally tackified with a resin. Page 3, line 5. The EP '585 resins relied on by the Examiner are aliphatic/aromatic petroleum resins and resins made by copolymerizing pure aromatic monomers with olefins. See the Final Office Action, page 2, line 3 from the bottom - page 3, line 1 and EP '585, page 3, lines 7 to 9.

First, the motivation to combine the teachings of these references is not established by the references themselves. The EP '585 reference is directed to a method for producing coated adhesive tapes and to an apparatus for their production, particularly to an improvement upon prior processes balancing the competing requirements of high solids concentration (less solvent removal) with low viscosity (coating processability). Page 2, lines 1-20. There is no disclosure of *any* use for the tapes produced according to the EP '585 invention (let alone automotive coating films as described in Dobashi et al.), and no explanation of whether or how the tapes described therein could work in the invention of Dobashi et al. In contrast, the Dobashi et al reference is directed to protective automotive coating films that do not deteriorate the appearance of the automobile. (Col. 1, lines 1-8; Col. 2, lines 19-26). The Examiner has not set forth a factual basis for combining these references that is supported by the evidence of record, and has not explained how a person of ordinary skill -- seeking to improve upon the Dobashi et al invention -- would be led to the disclosure of EP '585, which is not directed to the field of protective automobile coatings. *In re Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) ("when the issue is obviousness, . . . '[t]he factual inquiry whether to combine references must be thorough and searching" (citation omitted). . . . It must be based on



APPEAL BRIEF UNDER 37 C.F.R. § 41.37  
U.S. Appln. No.: 09/874,314  
Attorney Docket No.: Q64575

objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.”).

Second, and even *assuming* a person of ordinary skill would be led to the EP ‘585 reference beginning with Dobashi et al., the Examiner has not provided a sufficient evidentiary basis for asserting that the EP ‘585 reference provides the particular motivation to modify the teachings of the Dobashi et al reference in the manner the Examiner has done. *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ2d 57, 63 (CCPA 1979)(“[w]hen the USPTO seeks to rely on a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory.”); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 292, 227 USPQ 657, 670 (Fed. Cir. 1985); *In re Grabiak*, 769 F.2d 729, 732, 226 USPQ 870, 872 (Fed. Cir. 1985) (“The mere fact that it is *possible* to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination.” *Id.*, (citing *In re Bergel*, 292 F.2d 955, 956-57 (C.C.P.A. 1961 )); *Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1459, 221 USPQ 481, 488 (Fed. Cir. 1984). The Examiner relies on the following statement in the EP ‘585 reference as providing motivation to combine the tackifier component of the EP ‘585 reference with the tackifier subgroup disclosed in Col. 9 of the Dobashi et al reference:

“With a higher solids content, it would be possible to increase the speed of coating the substrate because there will be less evaporation of solvent to contend with thus increasing the capability of the coating line. The reduction in the amount of solvent to be evaporated from the coated [sic] also has economic and environmental benefits.”

EP ‘585 Reference, p. 2, lines 15 - 18; Office Action of April 1, 2004 at 3. Particularly, the Examiner stated his “belie[f] that one of ordinary skill, aware of the motivation [set forth above] and the resulting economic and environmental benefits attained therefrom” would incorporate the ‘585 resin into the film of Dobashi et al. Office Action of April 1, 2004 at 3. The Examiner’s *belief* as to *how* one of ordinary skill would consider the cited disclosure is not factual, objective evidence of motivation found in the prior art (*Lee*, supra at 1338, 61 USPQ2d at 1433), and the Examiner has not stated how -- *if at all* -- this disclosure provides the requisite motivation to combine the references. First, there is no teaching at all in the Dobashi et al reference suggesting that a low solids content, solvent evaporation, or environmental concerns were disadvantageous features of prior art protective films or their methods of manufacture. In fact, solids content, solvent removal and environmental concerns are not even disclosed in Dobashi et al. Thus, it is unclear *whether*, or *how*, a person of ordinary skill would have been led to the EP ‘585 reference or been motivated to modify Dobashi et al based on the process improvement teachings of EP ‘585 cited by the Examiner. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988) (wherein the Federal Circuit required “some objective

teaching in the prior art or that knowledge generally available that one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.”). As stated, the EP ‘585 reference fails to disclose any use for the tapes produced, and the Examiner has not shown how obviating the problems associated with the manufacture of adhesive tapes having undisclosed utility would have provided motivation to a person of ordinary skill to substitute a specific tackifier resin of EP ‘585 into the invention of the Dobashi et al reference.

The examiner’s general conclusion that a person of ordinary skill would have been motivated by the “resulting economic and environmental benefits” of the EP ‘585 process ignores: (1) the different fields of endeavor of each reference; (2) the different problems attempted to be solved by each inventive entity; and (3) the failure of both reference to substantiate the applicability or the incorporation of the other, and this falls short of the objective evidentiary basis required to support the combination. *In re Lee, supra* at 1344-45. *See also, In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)(deficiencies of references cannot be saved by appeals to ‘common sense’ and ‘basic knowledge’ without any evidentiary support.).

The second element of establishing a *prima facie* case of obviousness requires the Examiner to show a reasonable expectation of success. *Inland Steel, supra* at 1362-64. Both the *teaching* or suggestion to make the claimed invention and the reasonable expectation of success must be found in the prior art and can not be based on the applicants’ disclosure. *See In re Vaeck, supra* at 493. Here, the Examiner has not set forth any reasonable expectation of success,

that substituting the tackifiers of the EP '585 reference for the resins of the Dobashi et al reference would result in similar (or better) adhesive properties to (or than) those of Dobashi et al, or even that replacing the resins of Dobashi et al with the tackifiers of EP '585 would result in an adhesive layer with desirable properties.

Moreover, the ratio of rubber polymer to tackifier resin of EP '585 lies between 1:2 and 2:1, preferably 40:60 to 60:40, and more preferably in a 1:1 ratio. (EP '585 Page 4, lines 15-16). The only example present employs a 1:1 ratio. (EP '585 Page 5, lines 15-36). In stark contrast, the tackifier content of the Dobashi et al reference is 1-30 parts by weight, preferably 1-10 parts by weight, more preferably 3-8 parts by weight, per 100 parts by weight of the polymer that is the main component of the pressure sensitive adhesive. (Col. 5, lines 8-12). Thus, even when employed in the lowest amounts disclosed, the tackifiers of the EP '585 reference are present in a substantially higher content relative to polymer than the tackifiers of the Dobashi et al reference.

Importantly, Dobashi et al specifically state that a tackifier content as high as that disclosed in the EP '585 reference (and in contravention of the suggestion by the Examiner) would not work in the Dobashi et al reference, by teaching "[i]f the tackifier is added in an amount of less than 1 parts by weight, it cannot have substantial effects, and *if more than 30 parts by weight, it will undesirably cause blooming of adherends, adhesive transfer on adherends and a decrease in weatherability.*" (Col. 5, lines 12-16)(emphasis added). By distinguishing tackifier contents greater than 30 parts by weight, Dobashi et al teach away from the use of the EP '585 resins because their content relative to that of the rubber polymer is too

high. It is improper to combine references where the references themselves teach away from the combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983); MPEP §2145 (2004). Because incorporation of the EP '585 reference's tackifier in an amount greater than 30 parts by weight would render Dobashi et al unsatisfactory for its intended purpose, there is no motivation to make the claimed combination. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). For this reason, a person of ordinary skill would not have a reasonable expectation of success if combining the tackifiers disclosed in the EP '585 reference with the coating formulas of Dobashi et al.

The final requirement of establishing a *prima facie* case of obviousness is that the prior art references must teach or suggest all the claim limitations; the teaching or suggestion must be found in the prior art and not based on Applicants' disclosure. *See* MPEP § 706.02(j) (2004); MPEP §2143.03 (2004); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442-43 (Fed. Cir. 1991). Dobashi et al does not disclose the copolymer petroleum resins or the styrene/hydrogenated terpene copolymer resins of the present invention. Although aliphatic/aromatic petroleum resins are described in the EP '585 reference, as set forth above, Examiner has not satisfactorily provided the motivation to combine the references or provided any reasonable expectation that the EP '585 resins would result in similar (or better) adhesive properties to (or than) those of Dobashi et al.

For at least the foregoing reasons, Appellants respectfully submit that the Examiner has not carried his burden of establishing a *prima facie* case of obviousness.

2. Alternatively, Applicants Have Rebutted Any Inference of *Prima Facie* Obviousness

In the alternative, Appellants respectfully submit that any possible *prima facie* case of obviousness was overcome by the evidence in the original application, supplemented with the additional declaration evidence of record as set forth below.

The original application discloses in Examples 1-4 coating formulations having, e.g., a styrene/hydrogenated terpene copolymer resin and a polyisobutylene rubber in a 1:25 ratio (Ex. 1), a 0.5:25 ratio (Ex. 2), a 3:25 ratio (Ex. 3), and a 0.2:25 ratio (Ex. 4) on a wt. basis. The coatings were applied to substrates and the resulting films were subjected to a load test at 80°C for 24 hours, and separately, at 60°C and 95% RH for 24 hours, allowed to stand, and then peeled off. As shown in the Table (Page 19), the coating formulations of the invention contained no fouling when removed, as compared with Comparative Examples 1-2 (lacking the claimed copolymer resins), which showed fouling when removed. (Page 19). Similarly, Example 5 describes a coating formulation having, e.g., a hydrogenated aliphatic/aromatic copolymer petroleum resin and a polyisobutylene rubber in a 1:25 ratio on a wt. basis as in Example 1. As with Examples 1-4, the coating formulation of Example 5 showed no fouling relative to the Comparative compositions which lacked any of the claimed copolymer resins. These data demonstrate the superiority of the claimed coatings over compositions lacking the copolymer tackifiers of the invention.

In the present case, Appellants also submitted a Declaration under 37 C.F.R. § 1.132 executed by Mr. Tsuyoshi Inoue, a co-inventor of the present invention on January 30, 2004, a

copy of which is attached herewith. In the Declaration, a sheet was prepared in the same manner as Example 1 on page 16 of the present specification, except that the terpene resin of Dobashi et al (YS RESIN PX1150) was used in place of the styrene/hydrogenated terpene copolymer resin (Clearon K100). The sheet was evaluated in the same manner as described on page 19 of the present specification. The results obtained were compared with the results obtained in Examples 1 and 5 of the present application, wherein a styrene/hydrogenated terpene copolymer resin and a hydrogenated aliphatic/aromatic copolymer petroleum resins were used, respectively. The comparative results are summarized in the following table:

		Example 1 of Present Application	Example 5 of Present Application	Resin used in Dobashi*
Substrate		40 $\mu$ m thick propylene/polyethylene blend film		
Constitution of Pressure- sensitive Adhesive	Kind of resin	Styrene/hydrogenated terpene copolymer resin (Clearon K100)	Hydrogenated aliphatic/ aromatic copolymer resin (Arkon M100)	Terpene resin (YS RESIN PX1150)
	Amount of resin	1 part	1 part	1 part
	PIB	(PIB of Mw 870,000) : (PIB of Mw 80,000)=75:25		
	Thickness	10 $\mu$ m		
Fouling Evaluation Test	80°C, 24 hours	No fouling	No fouling	Fouling occurred
	600C/95%, 24 hours	No fouling	No fouling	Fouling occurred

---

\* U.S. Patent No. 5,643,676 to Dobashi *et al.*

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

U.S. Appln. No.: 09/874,314

Attorney Docket No.: Q64575

As the results in the above table show, when the sheets prepared according to the present invention, i.e., Examples 1 and 5, were applied to a paint film, no fouling occurred. In contrast, when the sheet prepared using the resin of Dobashi et al was applied to a paint film, fouling occurred. That is, the film prepared using the resin of Dobashi et al did not prevent fouling. As is apparent from the comparative data, the present invention provides unexpectedly superior results relative to Dobashi et al in terms of the fouling property, and thus would not have been obvious in view of Dobashi et al.

In the Advisory Action dated July 12, 2004, the Examiner stated that “the Examiner’s relied upon tackifier [i.e., aliphatic/aromatic petroleum resins and resins made by copolymerizing pure aromatic monomers with olefins of EP ‘585] is not the one which pertains to the showing set forth in the earlier presented Declaration [Under 37 C.F.R. § 1.132 filed January 30, 2004].” See the Advisory Action, page 2, lines 3-4.

Appellants respectfully disagree and submit that the data in the specification and Declaration are sufficient to rebut any inference of *prima facie* obviousness. Evidence of unexpected properties may be in the form of a comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. MPEP § 716.02(b) (2004). However, applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art. *In re Geiger*, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987). The CCPA has held that, “[r]equiring applicant to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed



APPEAL BRIEF UNDER 37 C.F.R. § 41.37

U.S. Appln. No.: 09/874,314

Attorney Docket No.: Q64575

invention under 35 U.S.C. § 103 ‘would be requiring comparison of the results of the invention with the results of the invention.’” *In re Chapman*, 357 F.2d 418, 422, 148 USPQ 711, 714 (CCPA 1966). However, this is exactly what the Examiner appears to require of Appellants -- a comparison of the present invention with a sheet prepared according to Dobashi et al but using the tackifier disclosed in the EP ‘585 reference. Clearly, the combination of the Dobashi et al film using a particular tackifier disclosed in the EP ‘585 reference is not in the prior art. Further, such comparison would amount to “requiring comparison of the results of the invention with the results of the invention,” which the CCPA has expressly considered to be improper. *Id.*

In the present case, in the Inoue Declaration, the comparison was made by using the terpene resin. The terpene resin was used in all of the working Examples in Dobashi et al, primarily relied upon by the Examiner, and thus is the closest prior art example. Accordingly, Appellants respectfully submit that the comparative data in the Inoue Declaration satisfies the requirements under MPEP § 716.02(b). For this reason, the Inoue Declaration must be considered by the Examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. § 103; MPEP § 716.01(a)(2004).

For these reasons, Appellants respectfully submit that the present invention is patentable over the Dobashi et al reference in view of the EP ‘585 reference and that the rejection is improper and should be reversed.

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37 and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37  
U.S. Appln. No.: 09/874,314  
Attorney Docket No.: Q64575

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Mark Boland/MRD Reg No. 32,197  
Fang Liu  
Registration No. 51,283

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: November 1, 2004

APPEAL BRIEF UNDER 37 C.F.R. § 41.37  
U.S. Appln. No.: 09/874,314  
Attorney Docket No.: Q64575

## CLAIMS APPENDIX

### CLAIMS 1 and 2 ON APPEAL:

1. A sheet for protecting a paint film, said sheet comprising a substrate and formed on one side thereof a rubber-based pressure-sensitive adhesive layer which comprises a rubbery polymer and incorporated therein at least one copolymer selected from the group consisting of styrene/hydrogenated terpene copolymer resins, and hydrogenated aliphatic/aromatic copolymer petroleum resins.

2. The sheet for protecting a paint film of claim 1, wherein the amount of the copolymer incorporated is from 0.2 to 5 parts by weight per 100 parts by weight of the rubbery polymer.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

U.S. Appln. No.: 09/874,314

Attorney Docket No.: Q64575

EVIDENCE APPENDIX

Pursuant to 37 C.F.R. § 41.37(c)(1) (ix), submitted herewith are copies of any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the appeal.

1. Executed Declaration Under 37 C.F.R. § 1.132 which has been submitted on January 30, 2004.